

### REMARKS

The present amendment places the application in condition for allowance or in better form for consideration on appeal. Therefore, in accordance with MPEP §714.12, the Applicants respectfully request that the present amendment be entered.

Upon entry of the present amendment, claims 11, 169-175, 178, 179, and 181-208 will be pending and under examination. Claim 177 has been cancelled. Claims 11, 170, 174, and 191 have been amended. Claims 11 and 170 has been amended to remove the phrase an "N-terminal fragment thereof." Claim 174 adopts much of the language of claim 11 for a method using "an N-terminal fragment of an H3 or an H4 histone protein." Support for "an N-terminal fragment of an H3 or an H4 histone protein" in amended claims 174 and 191 can be found in the specification as filed, e.g., in Figures 5A, 5B, and 5C, their descriptions on pages 10-11, and on pages 76-77.

### Rejections for Double Patenting

The Examiner rejected claims 1, 171, 173, 179, 181-185, 191-194 and 207-208 on the ground of nonstatutory obviousness-type double patenting (Office Action at page 3). According to the Examiner, the claims allegedly are "unpatentable over claims 118-130 of copending Application No. 09/735,786" (at page 3). The Examiner further stated at page 4 that: "[t]his is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented" (emphasis in the original).

The Applicants do not accede to the substance of this rejection. As noted by the Examiner this is a provisional rejection over the co-pending application 09/735,786. Accordingly, the Applicants request that the Examiner follow the procedures elaborated in MPEP § 804.I.B, which authorizes advancing one application to issuance where a provisional double patent rejection is made between two pending applications. The section states in particular:

The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than

one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications. If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent. [emphasis added]

Based on the present amendment, the Applicants expect that this provisional double patenting rejection will be "the only rejection remaining" in this application. The Examiner of 09/735,786 will be notified of the double patent rejection made in this application. The Applicants note that the 09/735,786 case has yet to be examined, despite the Applicants' inquiries. Further, this application has an earlier filing date than 09/735,786. Accordingly, the double patent rejection made in this application should be withdrawn so that, of the two, this application may be the first to issue as a patent.

#### **Rejections Under 35 U.S.C. § 112, First Paragraph**

The Examiner rejected claim 11, 169-175, 177-179, and 181-208 as allegedly failing to comply with the written description requirement, stating:

Applicant has amended claims 11, 170 and 191 to recite "or an N-terminal fragment thereof. . ." This phrase does not appear in the specification, or original claims as filed. Applicant does not point out specific basis for this limitation in the application, and none is apparent. Therefore this limitation is new matter (Office Action at page 4).

Without conceding the argument, but solely to expedite prosecution, the Applicants amended claims 11 and 170 to remove the phrase an "N-terminal fragment thereof," rendering the rejection of these claims moot. Claims 169, 171-173, 175, 178, 179, and 181-190 depend from claim 11, and their rejections are likewise rendered moot by this amendment. Claim 177 has been cancelled.

Applicants amended claims 174 and 191 to recite an N-terminal fragment of an H3 or an H4 histone protein. Support for amended claims 174 and 191 can be found in the specification as filed, e.g., in Figures 5A, 5B, and 5C and their descriptions on pages 10-11, and on pages 76-77. For example, Figure 5A "depicts the amino acid sequences of the N-terminal tails of H3 . . . and H4 . . . peptides," Figure 5B "depicts the effects of mSir2 $\alpha$  and ySir2p on

diacetylated H3 peptide (diAc), but not unacetylated H3 (unAc)," and Figure 5C "illustrates mSir2 $\alpha$  modification of Lys16-acetylated H4 peptide" (at pages 10-11, SEQ ID NOs omitted). Pages 76-77 of the specification further describe these experiments. Claims 192-208 depend from either claim 11 or 191.

Withdrawal of the written description rejections is respectfully requested.

**Conclusion**

The Applicants respectfully submit that all claims are in condition for allowance, which action is expeditiously requested. The Applicants do not concede any positions of the Examiner that are not expressly addressed above, nor do the Applicants concede that there are not other good reasons for patentability of the presented claims or other claims. All amendments and withdrawals are made without prejudice and disclaimer.

Enclosed is a Petition for One-Month Extension of Time and a check for the required fee. Please apply any other charges or credits to deposit account 06-1050, referencing Attorney's Docket Number 13407-016001.

Respectfully submitted,

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